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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,641	01/26/2007	Nicolai Tarasinski	09248W-US	4217
30680 7590 08/27/2008 DEERE & COMPANY ONE JOHN DEERE PLACE MOLINE, IL 61265				
EXAMINER				
TRIEU, THAI BA				
ART UNIT		PAPER NUMBER		
3748				
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08/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/572,641

**Applicant(s)**

TARASINSKI ET AL.

**Examiner**

Thai-Ba Trieu

**Art Unit**

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 7-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

1. The disclosure is objected to because of the following headings of the specification are missing, such as :

- ***Background of the invention.***
- ***Brief summary of the invention.***
- ***Brief Description of the Drawing(s).***
- ***Detailed Description of the Preferred embodiments.***

Appropriate correction is required.

2. Applicant discloses "The problem is solved ***according to the invention by teaching of claim 1***" (Page 4, line 17); however, claim may be amended or cancelled during the prosecution of the instant application, and therefore, is not an appropriate characterization of the invention.

### ***Claim Objections***

1. Claims 78-33 are objected to under 37 CFR 1.75(c) as being in improper form because multiple dependent claims 7-33 cannot depend from any other multiple dependent claims 2-6. See MPEP § 608.01(n). Accordingly, the claims 7-33 have not been further treated on the merits.

2. Claims 1-6 are objected to because of the following informalities:

Claim 1, line 1, "***Tire Pressure regulating system***" should be replaced by -- **A tire Pressure regulating system** --.

Claims 2-6, line 1, "***Tire Pressure regulating system***" should be replaced by -- **The tire Pressure regulating system** --.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is and its dependent claims 3-6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically,

- In claim 2, line 2 and claim 5 line 2, the recitation of "can be changed" renders the claim indefinite, since it is not clear that under which condition the geometry of the turbocharger can be changed by an adjustment of the guide blades, under which condition the geometry of the turbocharger cannot be changed by an adjustment of the guide blades. Applicants are required to define the conditions of the geometry of the turbocharger or to revise the claimed features.

- In claim 6, line 3, the recitation of "can be reduced" renders the claim indefinite, since it is not clear that under which the high-pressure or low-pressure diaphragm dashpot can be reduced, under which the high-pressure or low-pressure diaphragm dashpot cannot be reduced. Applicants are required to define the conditions of the geometry of the turbocharger or to revise the claimed features.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 1-4 is rejected under 35 U.S.C. 102(b) as best understood as being anticipated by Schmidt et al. (Patent Number 6,102,146).***

Schmidt discloses a system with a compressed-air source (2, 3, 4), wherein the vehicle has a combustion engine (1) with a turbocharger (2, 3, 4) and wherein the turbocharger (2,3,4) is provided as a compressed-air source for the tire-pressure regulating system, characterized:

in that the turbocharger (2, 3, 4) has a variable geometry (5) (See Figure 1);

in that the geometry of the turbocharger (2, 3, 4) can be changed by an adjustment of the guide blades (5) and/or the working blades;

in that the guide blades and/or the working blades are changed with reference to a charged air compressor part of the turbocharger (2, 3, 4);

in that the guide blades (5) and/or the working blades are changed with reference to the exhaust gas turbine part of the turbocharger (2, 3, 4) (See Figure 1, Column 3, lines 45-61).

With regard to the preamble directed to **“tire-pressure regulating system for setting the pressure of a tire (16) mounted on a vehicle”**, that pre-ambular

recitations apply to claim 1 have not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See MPEP 2111.02 **PREAMBLE STATEMENTS RECITING PURPOSE OR INTENDED USE**. See also *In re Schreiber*, 128 F. 3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. cir. 1997), and *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

The limitations of ***“for setting the pressure of a tire mounted on a vehicle”***, in lines 1-2, and ***“for the tire-pressure regulating system”***, in lines 3-4, are an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCCPA 1963).

It has been also held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Claims 1 is rejected under 35 U.S.C. 102(e) as best understood as being anticipated by Gerke et al. (Patent Number 6,625,984 B2).***

Gerke discloses a system with a compressed-air source (12), wherein the vehicle has a combustion engine (10) with a turbocharger (12) and wherein the turbocharger (12) is provided as a compressed-air source for the tire-pressure regulating system (10), characterized:

in that the turbocharger (12) has a variable geometry (50) (See Figure 1, Column 3, lines 19-40, 53-67, Column 4, lines 1-46);

in that the geometry of the turbocharger (12) can be changed by an adjustment of the guide blades (50) and/or the working blades;

in that the guide blades (50) and/or the working blades are changed with reference to a charged air compressor part of the turbocharger (12);

in that the guide blades (50) and/or the working blades are changed with reference to the exhaust gas turbine part of the turbocharger (12) (See Figure 1, Column 3, lines 19-40, 53-67, Column 4, lines 1-46).

With regard to the preamble directed to **“tire-pressure regulating system for setting the pressure of a tire (16) mounted on a vehicle”**, that pre-ambular recitations apply to claim 1 have not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory



clause. See MPEP 2111.02 **PREAMBLE STATEMENTS RECITING PURPOSE OR INTENDED USE**. See also *In re Schreiber*, 128 F. 3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. cir. 1997), and *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

The limitations of ***“for setting the pressure of a tire mounted on a vehicle”***, in lines 1-2, and ***“for the tire-pressure regulating system”***, in lines 3-4, are an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCCPA 1963).

It has been also held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Alternatively, Claims 1-4 are rejected under 35 U.S.C. 103(a) as best understood as being unpatentable over Tarasinski (Pub. Number US 2002/0121323 A1), in view of either Schmidt et al. (Patent Number 6,102,146), or Gerke et al. (Patent Number 6,625,984 B2).***

Tarasinski discloses a tire-pressure regulating system for setting the pressure of a tire (16) mounted on a vehicle, with a compressed-air source, wherein the vehicle has a combustion engine (20) with a turbocharger (22) and wherein the turbocharger (22) is provided as a compressed-air source for the tire-pressure regulating system (10).

However Tarasinski fails to disclose the turbocharger having a variable geometry and its functions.

Schmidt/Gerke teaches that it is conventional in the turbocharged internal combustion engine art, to utilize in that the turbocharger (2, 3, 4 of Schmidt, 12 of Gerke) has a variable geometry (5 of Schmidt, 50 of Gerke) (See Figure 1 of Schmidt, Figure 1, Column 3, lines 19-40, 53-67, Column 4, lines 1-46 of Gerke);

in that the geometry of the turbocharger (2, 3, 4 of Schmidt, 12 of Gerke) can be changed by an adjustment of the guide blades (5 of Schmidt, 50 of Gerke) and/or the working blades;

in that the guide blades (5 of Schmidt, 50 of Gerke) and/or the working blades are changed with reference to a charged air compressor part of the turbocharger (2, 3, 4 of Schmidt, 12 of Gerke);

in that the guide blades (5 of Schmidt, 50 of Gerke) and/or the working blades are changed with reference to the exhaust gas turbine part of the turbocharger (2, 3, 4 of Schmidt, 12 of Gerke) (See Figure 1, Column 3, lines 45-61 of Schmidt, Figure 1, Column 3, lines 19-40, 53-67, Column 4, lines 1-46 of Gerke).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized a variable geometry and its functions, as taught by

Schmidt/Gerke, to provide an alternative arrangement/design and to improve the control/regulation of the tire-pressure for the Tarasinski device.

Additionally, the substitution of a variable geometry as shown in Schmidt/Gerke for a waste gate shown in Tarasinski would have been obvious to one of ordinary skill in the art at the time of the invention since the substitution of a variable geometry as shown in Schmidt/Gerke would have yielded predictable results of controlling tire pressure which depends on the characteristics and functions of the variable geometry of the turbocharger. *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1395 (U.S. 2007).

***Claims 5-6 are rejected under 35 U.S.C. 103(a) as best understood as being unpatentable either Schmidt et al. (Patent Number 6,102,146), or Gerke et al. (Patent Number 6,625,984 B2), and further in view of either Allen et al. (Patent Number 6,705,084 B2) or Umehara et al. (Patent Number 6973785 B2).***

Schmidt/Gerke discloses the invention as recited above, however fails to disclose a high-pressure or low-pressure diaphragm dashpot.

Allan/Umehara teaches that it is conventional in the art of controlling system for electric assisted turbocharger, to utilize in that the geometry of the turbocharger (10 of Allan, 20, 21, 22 of Umehara) can be changed with the help of a high-pressure or low-pressure diaphragm dashpot (26 of Allan, 24, 25 of Umehara) connected to the turbocharger (10 of Allan, of 20, 21, 22 Umehara), wherein a preferably electrically-driven vacuum pump connected to a low-pressure diaphragm dashpot (26 of Allan, 24,

25 of Umehara) charges the low-pressure diaphragm dashpot with low pressure; in that the high pressure or low pressure between the vacuum pump and the high-pressure or low-pressure diaphragm dashpot (26 of Allan, 24, 25 of Umehara) can be reduced, so that the turbocharger (10 of Allan, 20, 21, 22 of Umehara) assumes its geometry corresponding to this state (see Column 5, lines 4-53 of Allan, Figure 1, Column 4, lines 40-50 of Umehara).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized a high-pressure or low-pressure diaphragm dashpot, as taught by Allan/Umehara, to improve the control of the guide vanes in the Schmidt/Gerke turbocharged internal combustion engine.

***Claims 5-6 are rejected under 35 U.S.C. 103(a) as best understood as being unpatentable over Tarasinski (Pub. Number US 2002/0121323 A1), in view of either Schmidt et al. (Patent Number 6,102,146), or Gerke et al. (Patent Number 6,625,984 B2), and further in view of either Allen et al. (Patent Number 6,705,084 B2) or Umehara et al. (Patent Number 6,973,785 B2).***

The modified Tarasinski discloses the invention as recited above, however fails to disclose a high-pressure or low-pressure diaphragm dashpot.

Allan/Umehara teaches that it is conventional in the art of controlling system for electric assisted turbocharger, to utilize in that the geometry of the turbocharger (10 of Allan, 20, 21, 22 of Umehara) can be changed with the help of a high-pressure or low-pressure diaphragm dashpot (26 of Allan, 24, 25 of Umehara) connected to the

turbocharger (10 of Allan, of 20, 21, 22 Umehara), wherein a preferably electrically-driven vacuum pump connected to a low-pressure diaphragm dashpot (26 of Allan, 24, 25 of Umehara) charges the low-pressure diaphragm dashpot with low pressure; in that the high pressure or low pressure between the vacuum pump and the high-pressure or low-pressure diaphragm dashpot (26 of Allan, 24, 25 of Umehara) can be reduced, so that the turbocharger (10 of Allan, 20, 21, 22 of Umehara) assumes its geometry corresponding to this state (see Column 5, lines 4-53 of Allan, Figure 1, Column 4, lines 40-50 of Umehara).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized a high-pressure or low-pressure diaphragm dashpot, as taught by Allan/Umehara, to improve the control of the guide vanes in the modified Tarasinski tire-pressure regulating system.

### ***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TTB  
August 25, 2008

/Thai-Ba Trieu/  
Primary Examiner  
Art Unit 3748